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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,864	12/26/2001	Yoshikazu Yokomizo	00862.022477	7550

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FITZPATRICK CELLA HARPER & SCINTO  
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NEW YORK, NY 10112

EXAMINER
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HOSSAIN, FARZANA E

ART UNIT	PAPER NUMBER
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2623

MAIL DATE	DELIVERY MODE
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08/15/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/025,864	YOKOMIZO, YOSHIKAZU	
	Examiner	Art Unit	
	Farzana E. Hossain	2623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 June 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,8-13 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,8-13 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/07/2007 has been entered.

### ***Response to Amendment***

2. This office action is in response to communications filed 06/07/2007. Claims 1, 8-13 and 25 are amended. Claims 2 and 3 are original. Claims 4-7 and 14-24 have been cancelled.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3, 8-13 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoff et al (2005/0015815 and hereafter referred to as "Shoff") in view of Goldman et al US (7,051,351 and hereafter referred to as "Goldman").

Regarding Claim 1, Shoff discloses an Internet DTV system having:

a digital broadcast station or broadcast headend (Figure 4, 22) that broadcasts a program by using a well-known broadcast radio wave (Page 3, paragraph 0032);

a content management server provided on the Internet that manages and delivers second programs or hypertext files such as HTML documents (Figure 4, 22, 44);

a commercial server including commercial contents of said second programs (Figure 4, 54, 80); and

a terminal, provided on an audience side, that receives a digital broadcast and accesses the Internet (Figure 1, Figure 4, 62). Merriam-Webster's 10<sup>th</sup> edition Collegiate Dictionary defines sponsor as a person or an organization that pays for or plans and carries out a project or activity especially one that pays the cost of radio or television program usually in return for advertising time during its course. Shoff

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discloses advertising and merchandise, which is related to the program which is therefore provided by a sponsor (Page 3, paragraph 0036, Page 2, paragraph 0018).

Shoff discloses wherein the broadcast station comprising:

broadcasting means for broadcasting information described in a predetermined format specifying the first program as the receiver receives broadcast data in a format such as digital or analog (Page 3, paragraph 0034), display of a second program to be selected by an audience (Page 3, paragraph 0047, Figure 6, Figure 7), address information indicating a location of content upon selection of the second program or hyperlink or pointer or any other designation or URL of the content upon selection, and a sponsor of the first program (Page 3, paragraphs 0035, 0040, Page 4, paragraphs 0043-0047, Figure 3, 58),

and wherein the terminal comprising:

means for receiving information from the broadcast station (Figure 1, Figure 4, 74); access means for accessing the Internet (Figure 4, 74, 82, Figure 5, Page 4, paragraph 0054);

first output means for combining the received program with the second program in accordance with received description and outputting the program to a predetermined display device (Page 4, paragraph 0054, Page 5, paragraphs 0059-0061, Page 7, Table 1, Page 8, Table 2);

input means for inputting designation information from an operator (Figure 4, 74, 82, Figure 5, page 4, paragraph 0054, Page 7, Table 1, paragraphs 0081-0090, Page 8, Table 2, paragraphs 0091-0092);

request means for, if an input designation is related to the second program, accessing the content management server by the access means by using a described URL for the second program (Page 5, paragraph 0065), and issuing a request for transfer of the content by selecting content for display (Page 3, paragraphs 0036-0039); and

second output means for outputting the content received from the content management server to the display device as it is necessarily included that the terminal displays the content received from the content management server (Page 3, paragraphs 0036-0039). Shoff discloses that the commercial server comprises a database that holds commercial contents (Figure 4, 52, 54, 80, 86). It is necessarily included that the commercial server comprises searching means for searching for a corresponding commercial content from the data based on information specifying the sponsor of the first program as the URL includes information about the advertisement or merchandise (Figure 3, 58) from the content management server (Page 3, paragraphs 0035-0039, Page 4, paragraphs 0042-0047, Figure 6, Figure 7).

Shoff does not explicitly disclose content management server comprising: and combining means for combining the commercial content sent from the commercial server with the content requested by the terminal and transmitting the information to the terminal, further wherein the commercial server comprising: information determining the combination of the sponsor and the commercial content of the second program, and notifying the commercial content to the content management server.

In analogous art, Goldman discloses a content management server (Figure 3A, 16) and a commercial server (Figure 3A, 66) and a content management server comprising combining means for combining the commercial content sent from the commercial server with the content requested by the terminal (Column 9, lines 20-45) and commercial server comprising information determining the combination of the sponsor of the first program or advertiser of the first program as any one or organization paying for advertising during a program (Column 11, lines 35-46, Column 2, lines 44-56) and notifying the commercial content to the content management server (Column 9, lines 7-19). Therefore, it would have been obvious to one of ordinary skill in the art to modify Shoff to include a content management server comprising combining means for combining the commercial content sent from the commercial server with the content requested by the terminal (Column 9, lines 20-45) and commercial server comprising information determining the combination of the sponsor of the first program or advertiser of the first program as any one or organization paying for advertising during a program (Column 11, lines 35-46, Column 2, lines 44-56) and notifying the commercial content to the content management server (Column 9, lines 7-19) as taught by Goldman in order to provide advertising effectiveness and to collect more advertising fees from advertisers (Column 2, lines 44-56) as taught by Goldman.

Regarding Claims 8 and 9, Shoff discloses a terminal and a control method for a terminal having an Internet access function provided on the audience side for receiving a first program from a digital broadcast station outputting a content to a predetermined

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display device (Figure 4, 22, Page 3, paragraph 0032, Figure 1, Figure 4, 62, Figure 4, 74, 82, Figure 5, Page 4, paragraph 0054), comprising: receiving means for receiving information from the broadcast station (Figure 1, Figure 4, 74); access means for accessing the Internet (Figure 4, 74, 82, Figure 5, Page 4, paragraph 0054); first output means for combining the received first program with the second program in accordance with received description and outputting the program to a predetermined display device (Page 4, paragraph 0054, Page 5, paragraphs 0059-0061, Page 7, Table 1, Page 8, Table 2). Merriam-Webster's 10<sup>th</sup> edition Collegiate Dictionary defines sponsor as a person or an organization that pays for or plans and carries out a project or activity especially one that pays the cost of radio or television program usually in return for advertising time during its course. Shoff discloses advertising and merchandise, which is related to the program which is therefore provided by a sponsor (Page 3, paragraph 0036, Page 2, paragraph 0018). Shoff discloses input means for inputting designation information from an operator (Figure 4, 74, 82, Figure 5, page 4, paragraph 0054, Page 7, Table 1, paragraphs 0081-0090, Page 8, Table 2, paragraphs 0091-0092); request means for, if an input designation is related to the second program, accessing the content management server by the access means by using a described URL for the second program (Page 5, paragraph 0065), notifying information to specify the sponsor of the first program (Figure 3, 58) and issuing a request for transfer of the content by selecting content for display (Page 3, paragraphs 0036-0039); and second output means for outputting the content received from the content management server to the display device as it is necessarily included that the terminal displays the content

received from the con (Page 3, paragraphs 0036-0039). Shoff discloses that the commercial server comprises a database that holds commercial contents (Figure 4, 52, 54).

Shoff does not explicitly disclose information determining a combination of the sponsor and the commercial content of the second program, and notifying the commercial content to the content management server.

In analogous art, Goldman discloses a content management server (Figure 3A, 16) and a commercial server (Figure 3A, 66) and a content management server comprising combining means for combining the commercial content sent from the commercial server with the content requested by the terminal (Column 9, lines 20-45) and commercial server comprising information determining the combination of the sponsor of the first program or advertiser of the first program as any one or organization paying for advertising during a program (Column 11, lines 35-46, Column 2, lines 44-56) and notifying the commercial content to the content management server (Column 9, lines 7-19). Therefore, it would have been obvious to one of ordinary skill in the art to modify Shoff to include a information determining a combination of the sponsor of the first program or advertiser of the first program as any one or organization paying for advertising during a program (Column 11, lines 35-46, Column 2, lines 44-56) as taught by Goldman in order to provide advertising effectiveness and to collect more advertising fees from advertisers (Column 2, lines 44-56) as taught by Goldman.

Regarding Claim 10, Shoff discloses a computer readable storage medium or a storage medium or computer or set top box (Figure 5, Page 4, paragraph 0054) on which a computer executable program that functions (Page 4, paragraph 0054, Page 5, paragraphs 0055-0057) as a terminal having an Internet access function (Page 4, paragraph 0054, Page 5, paragraph 0055-0057) provided on the audience side (Figure 4, 62, Figure 1) for receiving a digital broadcast (Figure 1, Figure 4, Page 3, paragraph 0032) and outputting the program to a predetermined display device (Figure 4, 62, 66, Figure 1); wherein the program comprises computer code or software (Page 4, paragraph 0054, Page 5, paragraph 0055-0057, Figure 5, Figure 4) of process for the disclosed in the above rejections of Claims 8 and 9.

Regarding Claims 11 and 12, Shoff discloses a content management server and a control method for a content management server for transferring a content in response to a request from a terminal having an Internet access function, where the terminal is provided on provided on an audience side, receives a digital broadcast including a first program from a digital broadcast station and outputs a video signal to a predetermined display device (Figure 4, 22, Page 3, paragraphs 0032, 0035-0039, Figure 1, Figure 4, 62, Figure 4, 74, 82, Figure 5, Page 4, paragraph 0054, Figure 6, Figure 7); comprising: a second program database that holds and manages the second program (Figure 4, 44, 46, Page 3, paragraph 0035-0040), first reception means for receiving information specifying the content (Figure 3, Figure 4, Figure 5). Merriam-Webster's 10<sup>th</sup> edition Collegiate Dictionary defines sponsor as a person or an organization that pays for or plans and carries out a project or activity especially one

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that pays the cost of radio or television program usually in return for advertising time during its course. Shoff discloses advertising and merchandise, which is related to the program which is therefore provided by a sponsor (Page 3, paragraph 0036, Page 2, paragraph 0018). Therefore first reception means receive information specifying a sponsor of the first program which has been received by the terminal from the digital broadcast station (Figure 3, 58, Page 4, paragraphs 0042-0047); based on the information specifying the sponsor of the first program received by the first reception means, requesting transfer of commercial content from a predetermined commercial server provided on the Internet (Figure 4, 52, 82); and transmission means for extracting the second program requested from the terminal from the database (Page 4, paragraphs 0042-0047). Shoff discloses that the content management server at the headend receives a request from the user, however is silent on second reception means for, based on information determining a combination of the sponsor of the first program and a commercial content of the second program, a second reception means receiving the commercial content, and transmission means from the database, combining the second program with the commercial content received by the second reception means, and transmitting the content to the terminal.

In analogous art, Goldman discloses a content management server (Figure 3A, 16) and a commercial server (Figure 3A, 66) and second reception means based on information determining the combination of the sponsor of the first program or advertiser of the first program as any one or organization paying for advertising during a program (Column 11, lines 35-46, Column 2, lines 44-56), receiving the commercial content

(Column 11, lines 35-46), transmission means extracting the second program requested from the terminal, from the database, combining the second program with the commercial content received by the second reception means and transmitting the combined content to the terminal (Column 9, lines 7-45). Therefore, it would have been obvious to one of ordinary skill in the art to modify Shoff to include second reception means based on information determining the combination of the sponsor of the first program or advertiser of the first program (Column 11, lines 35-46, Column 2, lines 44-56), receiving the commercial content (Column 11, lines 35-46), transmission means combining the second program with the commercial content received by the second reception) as taught by Goldman in order to provide advertising effectiveness and to collect more advertising fees from advertisers (Column 2, lines 44-56) as taught by Goldman.

Regarding Claim 13, Shoff discloses a content management server for transferring a content in response to a request from a terminal having an Intent access function, where the terminal is provided on provided on an audience side, receives a digital broadcast including a first program from a digital broadcast station and outputs a video signal to a predetermined display device (Figure 4, 22, Page 3, paragraphs 0032, 0035-0039, Figure 1, Figure 4, 62, Figure 4, 74, 82, Figure 5, Page 4, paragraph 0054, Figure 6, Figure 7). The Microsoft Press 3<sup>rd</sup> edition Computer Dictionary defines a server runs administrative software the controls access to the network and resources and On the internet or other network, a computer or program that responds to commands from a client, for example a file server contain an archive of data or program

files; when a client submits a request for a file, the server transfers a copy of the file to the client. Therefore, it is inherent that a computer readable storage medium or on which is stored a computer executable program for the server to perform functions for a terminal having an Internet access function, provided on the audience side for receive a digital broadcasting and outputting a video signal to a predetermined display device (Figure 4, 22, Page 3, paragraph 0032, Figure 1, Figure 4, 62, Figure 4, 74, 82, Figure 5, Page 4, paragraph 0054). See rejections of Claims 11 and 12.

Regarding Claim 25, Shoff disclose a display device comprising: receiving means for receiving first and second programs ((Figure 5, 98, 100, Figure 4, 62, display means for display the first and second programs in parallel (Page 3, paragraph 0032, 0035-0039, Figure 1, Figure 4, 62, Figure 4, 74, 82, Figure 5, Page 4, paragraph 0054). Shoff discloses display control means for displaying a commercial content of the second program (Page 3, paragraph 0032, Figure 1, Figure 4, 62, Figure 4, 74, 82, Figure 5, Page 4, paragraph 0054). Merriam-Webster's 10<sup>th</sup> edition Collegiate Dictionary defines sponsor as a person or an organization that pays for or plans and carries out a project or activity especially one that pays the cost of radio or television program usually in return for advertising time during its course. Shoff discloses advertising and merchandise, which is related to the program which is therefore provided by a sponsor (Page 3, paragraph 0036, Page 2, paragraph 0018). Shoff discloses display control means for displaying commercial content of the second program is determined based on information specifying a sponsor of the first program (Figure 3, 58). Shoff does not

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explicitly disclose information determining a combination of the sponsor and the commercial content of the second program.

In analogous art, Goldman discloses a content management server (Figure 3A, 16) and a commercial server (Figure 3A, 66) and a content management server comprising combining means for combining the commercial content sent from the commercial server with the content requested by the terminal (Column 9, lines 20-45) and commercial server comprising information determining the combination of the sponsor of the first program or advertiser of the first program as any one or organization paying for advertising during a program (Column 11, lines 35-46, Column 2, lines 44-56) and notifying the commercial content to the content management server (Column 9, lines 7-19). Therefore, it would have been obvious to one of ordinary skill in the art to modify Shoff to include information determining a combination of the sponsor of the first program or advertiser of the first program as any one or organization paying for advertising during a program (Column 11, lines 35-46, Column 2, lines 44-56) as taught by Goldman in order to provide advertising effectiveness and to collect more advertising fees from advertisers (Column 2, lines 44-56) as taught by Goldman.

Regarding Claim 3, Shoff and Goldman disclose all the limitations of Claim 1. Shoff discloses that the terminal has a form of set top box connected to a television receiver owned by the audience (Page 2, paragraph 0016).

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shoff in view of Goldman as applied to claim 1 above, and further in view of Rajan (WO 00/01154).

Regarding Claim 2, Shoff and Goldman disclose all the limitations of Claim 1. Shoff discloses receiving a digital broadcast and receiving digital data (Page 4, paragraph 0034). Shoff and Goldman are silent on the terminal further comprises: an MPEG2 decoder for a digital broadcast; means for interpreting a BIFS description as a scene description; and means for decoding MPEG4 data from the content management server. Rajan discloses a terminal with a MPEG2 decoder for a digital broadcast (Page 12, lines 1-12, Page 4, lines 3-7, Figure 1, 133, 122); means for interpreting a BIFS description as a scene description (Figure 1, 122, Page 10, lines 9-30, Page 11, lines 1-31); and means for decoding MPEG4 data (Figure 1, 122-133, Page 19, lines 3-9) from the content management server or server (Page 10, lines 9-19). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination to include a terminal with a MPEG2 decoder for a digital broadcast (Page 12, lines 1-12, Page 4, lines 3-7, Figure 1, 133, 122); means for interpreting a BIFS description as a scene description (Figure 1, 122, Page 10, lines 9-30, Page 11, lines 1-31); and means for decoding MPEG4 data (Figure 1, 122-133, Page 19, lines 3-9) from the content management server or server (Page 10, lines 9-19) as taught by Rajan in order to present multimedia program using MPEG-4 standard which allows easier manipulation (Page 1, lines 7-15, Page 2, lines 12-22) as disclosed by Rajan.

**Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Farzana E. Hossain whose telephone number is 571-272-5943. The examiner can normally be reached on Monday to Friday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FEH  
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